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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number Q103095 | |
| Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 | Application Number | Filed | |
| | 10/510,274 | October 5, 2004 | |
| | First Named Inventor | | |
| | Pierre ROUX | | |
| | Art Unit | Examiner | |
| | 2617 | Michael T. THIER | |
| <p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER s</p> | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number <u>28,703</u></p> <p style="text-align: right;"><u>/DJCushing/</u> Signature</p> <p style="text-align: right;"><u>David J. Cushing</u> Typed or printed name</p> <p style="text-align: right;"><u>(202) 293-7060</u> Telephone number</p> <p style="text-align: right;"><u>April 22, 2009</u> Date</p> | | | |

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q103095

Pierre ROUX, et al.

Appln. No.: 10/510,274

Group Art Unit: 2617

Confirmation No.: 1567

Examiner: Michael T. THIER

Filed: October 5, 2004

For: METHOD FOR CONTROLLING RADIO RESOURCES ASSIGNED TO A
COMMUNICATION BETWEEN A MOBILE TERMINAL AND A CELLULAR
INFRASTRUCTURE, AND FACILITIES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the
Examiner's Final Office Action dated October 22, 2008 ("the Office action"), Applicant files this
Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a
Notice of Appeal.

Claims 1-50 stand in the application. The examiner has indicated allowable subject
matter in claims 15, 18, 19, 21, 23, 34, 36 and 37. Claims 1, 25, 38 and 44 are rejected for
obviousness-type double patenting over co-pending application 10/483,119 in view of Park et al
(US 2003/0013476).¹ Claims 1-4, 6-8, 11, 13, 14, 25, 26, 28-30, 32, 33, 38 and 40-46 are

¹ Although not included in the double patenting rejection as stated at page 5 of the Office action, , the
examiner later (at the bottom of page 7) refers to claims 2-24, 26-37, 39-43 and 45-46 as depending
...(footnote continued)

rejected for as unpatentable over Tiedemann et al (WO 99/13675) in view of Park et al. Claims 5, 27, 12 and 31 are rejected as unpatentable over Tiedemann et al in view of Park et al and further in view of Davis et al (USP 6,260,062). Claims 9 and 10 are rejected as unpatentable over Tiedemann et al in view of Park et al, and further in view of Takeo (USP 6,385,183). Claims 16, 17, 20, 24 and 35 are rejected as unpatentable over Tiedemann in view of Park et al and further in view of Akatsu et al (USP 6,505,255). Claims 39 and 53 are rejected as unpatentable over Tiedemann et al in view of Park et al and further in view of Sudo (USP 6,625,202). Claims 47-50 are rejected as unpatentable over Tidemann in view of Park et al, and further in view of Ichiyanagi (USP 5,867,769).

The present invention is a technique of managing resources in a mobile communications system, where the mobile terminal is in communication with plural different fixed transceivers, and parameters of the propagation channels between the mobile terminal and each of the transceivers are measured. A report based on these measurements is sent to the radio network controller, and the radio network controller then processes the reports to control the network resources accordingly. This is as described in the present specification beginning at line 24 of page 4 through line 5 of page 5, beginning at line 12 of page 21, and elsewhere. A distinctive feature of the present invention is that the data included in the reports sent to the network

from claims 1, 25, 38 and 44 “and therefore rejected for the same reasons.” If a parent claim is unpatentable, it does not at all follow that all dependent claims are also necessarily unpatentable, so this statement is not understood. So it is not clear if these claims have been rejected for obviousness-type double patenting and, if so, is also not clear what the rationale is for that rejection. This deficiency will be moot in view of the lack of a prima facie case for the rejection of the parent claims, but applicant reserves the right to argue the separate patentability of the dependent claims.

controller includes data representing a time variability of the power level received on the channel between the mobile terminal and the fixed transceiver. This is described at lines 6-10 of page 5. Examples are given elsewhere in the specification, e.g., lines 8-13 of page 7 describe that it can be the variance of the data. It is important to note that time variability of data is clearly not an average of the data over some period of time, because that would not show whether it had varied at all. And it is further clear from the specification and claims that this is how the term “time variability” is used. For example, note that claim 2 states that the variability data of a power level *include* an estimated variance of a time distribution of said power level, but when claim 4 talks about the average value of a power it states that this is *in addition* (i.e., “further comprises”), and notably does not state that this is part of the variability data.

In both the double patenting rejection and in the 35 USC 103 rejections, the examiner acknowledges that the primary reference (either the claims of the co-pending application or the teaching of Tiedemann et al) fails to teach the claimed measurement parameters that include time variability of the received power level, and he relies on Park et al to teach this feature. Park et al teaches averaging power level over a period of time, and the examiner broadly reads the present claims to encompass this. The flaw in this line of reasoning by the examiner is explained in the Amendment filed June 11, 2008 in the present case, starting at line 5 of page 16 and continuing to line 8 of page 17.

The examiner responds to this distinction at pages 2-3 of the final Office action by explaining that Park et al measures an average, that an average must occur over a time interval, and that the average value therefore “represents” a time variability of the power level. The

examiner dismisses the separate patentability of claims 2 and 3 on the grounds that the claimed “estimated variance” of claim 2 can be broadly considered to be an average.

With respect first to claim 2, the examiner has given no justification for taking a clear claim term (“variance”) that has a universally well-understood meaning in this and every other art, and simply changing the definition to suit his rejection. The average value does not represent the variance, by any reasonable definition.

As to claim 3, it recites that the time variability data further comprise at least one estimation of a moment of order greater than 2 of said time distribution of the power level. Determining a moment of order (i.e., exponent) greater than two is described at lines 1-6 of page 22. This is something completely different from an average taken over two time periods.

Claim 4 requires that the report include average data in addition to the time variability data, and this of course makes no sense if one reads time variability data as meaning average data, as the examiner seeks to do.

Claims 47-50 were added for the specific purpose of precluding the odd claim construction of the examiner. These claims all recite that the time variability data represents an amount of variation of the power level. Even the examiner would have to agree that it would be impossible for anyone to tell anything at all about the amount of variation of the power level during an interval if all that is given is the average value.

These are but a few examples of how the dependent claims further distinguish over the prior art relied on by the examiner. But what cannot be overlooked is that all of the independent claims require data representing time variability of the power level, and the average value use by

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Park et al obliterates that time variability information. The power level could be vary wildly over an interval and end up with an average, or could have been perfectly constant oat the average value over that same interval, and the end result average value would be exactly the same. So it is not possible to an average value to “represent” time variability.

For the above reasons, reversal of the examiner on all rejections is believed appropriate.

Respectfully submitted,

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23373

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Date: April 22, 2009

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